

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

BROADCOM CORPORATION,
Patent Owner.

Cases

IPR2017-01637 (Patent 7,590,059 B2)
IPR2017-01675 (Patent 7,310,104 B2)¹

Before THOMAS L. GIANNETTI, DANIEL J. GALLIGAN, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

ORDER

Termination of Trial

35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties are not authorized to use a multiple case caption.

IPR2017-01637 (Patent 7,590,059 B2)

IPR2017-01675 (Patent 7,310,104 B2)

I. DISCUSSION

On April 9, 2018, with Board authorization, the parties filed in each of IPR2017-01637 and IPR2017-01675 a Joint Motion to Terminate² along with what they indicate is a true copy of their settlement agreement.³ In the Joint Motions to Terminate, the parties represent that they have settled their disputes regarding the patents at issue in these proceedings, including the litigation before the U.S. District Court for the Central District of California and before the U.S. International Trade Commission, and they state that “[t]here are no additional collateral agreements or understandings made in connection with, or in contemplation of, termination of the *inter partes* review.”⁴

In each of these proceedings, the parties also filed a Joint Request to have their settlement agreement treated as business confidential information and kept separate from the file of the respective patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).⁵

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Further, under 35 U.S.C. § 317(b),

[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review

² IPR2017-01637, Paper 12; IPR2017-01675, Paper 11.

³ IPR2017-01637, Ex. 1016; IPR2017-01675, Ex. 1024.

⁴ IPR2017-01637, Paper 12, 1–2; IPR2017-01675, Paper 11, 1–2.

⁵ IPR2017-01637, Paper 13; IPR2017-01675, Paper 12.

IPR2017-01637 (Patent 7,590,059 B2)

IPR2017-01675 (Patent 7,310,104 B2)

under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination.

As the parties have filed their written settlement agreement and jointly requested termination, we determine that it is appropriate to terminate these proceedings without rendering final written decisions under 35 U.S.C. § 318(a). *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74.

Accordingly, the Joint Motions to Terminate the above-identified proceedings and the Joint Requests to treat the settlement agreement as business confidential information are granted. As requested by the parties, the settlement agreement will be treated as business confidential information and will be kept separate from the patent file. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Therefore, it is

ORDERED that the parties' Joint Requests that their settlement agreement (IPR2017-01637, Ex. 1016; IPR2017-01675, Ex. 1024) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are GRANTED; and

FURTHER ORDERED that the parties' Joint Motions to Terminate these proceeding are GRANTED, and these proceedings are hereby terminated.

IPR2017-01637 (Patent 7,590,059 B2)

IPR2017-01675 (Patent 7,310,104 B2)

PETITIONER:

Erika Arner
erika.arners@finnegan.com

Joshua Goldberg
joshua.goldberg@finnegan.com

Cory Bell
cory.bell@finnegan.com

PATENT OWNER:

John Caracappa
jcaracap@steptoe.com

Thomas Yebernetsky
tyebernetsky@steptoe.com